

REMARKS

In the Office Action, claims 1-31 were rejected. By the present Response, claims 1, 4, 14, 24, 27, and 28 are amended. Upon entry of the amendments, claims 1-5, 7-24, 26-29, and 31 will remain pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

Incompleteness of the Office Action

On a preliminary note, Applicants respectfully note that the present Office Action fails to address the status of claims 3, 7-13, 15-17, 20-23, 26, 29, and 31. In particular, while the Office Action Summary sheet indicates that claims 1-31 are rejected, the Office Action does not provide any rejection of the aforementioned claims and, thus, Applicants are deprived of any opportunity to meaningfully respond or advance the prosecution of claims 3, 7-13, 15-17, 20-23, 26, 29, and 31. As the Examiner will appreciate, 37 C.F.R. § 1.104 specifically states:

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made.

(c) *Rejection of claims.* . . . (2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104.

Further, the Manual of Patent Examining Procedure, Section 707.07(d) states that the ground of rejection for each claim should be “fully and clearly stated,” and Section 707.07(i) states that “[i]n every Office action, each pending claim should be mentioned

by number, and its treatment or status given.” In view of these passages, among others, Applicants stress that the present Office Action is incomplete with regard to the pending claims, particularly claims 3, 7-13, 15-17, 20-23, 26, 29, and 31. Consequently, Applicants respectfully request that the Examiner issue a communication clarifying the status of claims 3, 7-13, 15-17, 20-23, 26, 29, and 31. Applicants emphasize that such a communication, if issued as an Office Action, should not be final in view of the incomplete nature of the present Office Action.

Rejections Under 35 U.S.C. §103

In the Office Action, the Examiner rejected claims 1, 2, 4, 5, 14, 18, 19, 24, 25, 27, 28 and 30 under 35 U.S.C. §103(a) as being unpatentable over Campbell, U.S. Patent No. 6,047,259 (hereinafter referred to as “Campbell”) in view of Teshima, U.S. Patent No. 6,272,470 (hereinafter referred to as “Teshima”). Applicants respectfully traverse these rejections.

Legal Precedent and Guidelines

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). However, a claimed invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* Specifically, there must be

some articulated reasoning with a rational underpinning to support a conclusion of obviousness; a conclusory statement will not suffice. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Indeed, the factual inquiry determining whether to combine references must be thorough and searching, and it must be based on objective evidence of record. *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002).

Furthermore, there must be some reason to combine references other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)).

In addition, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. §2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. §2143.01(VI). Further, if the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see* M.P.E.P. §2143.01(V).

Deficiencies of the Rejections of Independent Claims 1, 4, 14, 24, 27 and 28

Independent claims 1, 4, 24, 28, as amended, recite “storing the digital file including the text, the image, and the waveform.” (Emphasis added.) A similar feature is recited in independent claims 14 and 27, as amended. More specifically, claim 14 recites “storing the multi-media patient summary, including the text, the image, and the waveform”, and claim 27 recites a feature of “storing the electronic file including the text, the image, and the waveform”. Furthermore, independent claims 1, 4, 14, 28, as amended, also recite accessing and/or loading the aforementioned digital file by “client workstations coupled to the compilation workstations via a network.” (Emphasis added.) A similar feature is recited in claims 24 and 27, as amended. More specifically, claim 24 recites “at least one client workstation coupled to the compilation workstation via a network and capable of accessing the digital file”, and claim 27 recites “means for accessing the electronic file via a network.” Thus, Applicants’ amended independent claims 1, 4, 14, 24, 27, and 28 recite a digital file, including the text, the image, and the waveform, that can be accessed or loaded from a remote client workstation coupled to the compilation workstation via a network.

As the Examiner has correctly pointed out, Campbell does not disclose the features of accessing and/or loading a digital file which includes text, an image and a waveform. *See* Office Action, page 4. Applicants respectfully note that Teshima does not obviate the deficiency. By way of contrast, Teshima teaches access to information through a digital file which stores links to the information, not the actual information itself. For example, Teshima states that the invention consists of “means for converting or producing link information in the consultation record when the consultation record is written in the storage medium”. (Emphasis added.) *See* Teshima, col. 3, lines 61-67. Teshima is directed to embodiments that address the problem of storage capacity by creating files with many reference links so that the resulting files can be portable. *See id.*, col. 3, lines 8-25. In addition to missing the recited feature, Teshima teaches away from

Applicants' claims because Teshima teaches that portable files should use links and not store text, an image, and a waveform. As the Examiner can appreciate, images and waveforms are particularly notorious for having large storage sizes. A person of ordinary skill in the art would read Toshima and be led to a solution that uses file links instead of storing large quantities of image and waveform data in the remote client file. Applicants' digital file, on the other hand, does not rely simply on links to the information but the information itself (e.g., text, image, and a waveform).

Furthermore, unlike when using a patient card, the file is always accessible from a remote client coupled to a compilation workstation via a network. As the Examiner has correctly pointed out, Campbell does not disclose the feature of accessing patient information from one or more systems to a compilation workstation. *See* Office Action, page 5. Teshima does not obviate this deficiency. Even assuming, *arguendo*, that Teshima teaches a compilation workstation, the Teshima teachings are directed at accessing information through a patient card. The whole point of Teshima is to allow a patient to carry information links stored in patient cards, which are clearly not coupled to anything, much less a compilation workstation. Should the patient card be lost, the information links will be lost and the information that the patient card links to will either be inaccessible or require some unmentioned workaround to access. By way of contrast, Applicants' claims are directed at files which are always accessible by remote clients coupled to a compilation workstation via a network. No intermediary feature, such as a patient card, is needed in Applicants' claims in order to access the file from a remote client coupled to a compilation workstation via a network.

For at least these reasons among others, Applicants submit that the combination of Campbell and Teshima cannot support a prima facie case of obviousness, and should be withdrawn. Applicants respectfully request withdrawal of the rejections under 35 U.S.C.

§ 103 and allowance of claims 1, 4, 14, 24, 27, and 28 as well as those claims depending therefrom.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: September 9, 2009

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